

## **REMARKS**

This application has been reviewed in light of the Office Action mailed September 5, 2006. Reconsideration of this application in view of the below remarks is respectfully requested. Claims 1 – 16 are pending in the application with Claims 1, 13 and 16 being in independent form. By the present amendment, Claims 1 and 13 are amended, and Claims 12 and 15 are canceled.

By way of the present amendment, Claims 1 and 13 have been amended to recite: "...a verification requesting means for issuing an audible verification request when the instruction is predetermined to require verification prior to execution..." Also, Claim 1 has been amended to replace: "...a voice and character converting step..." with "...a voice and character converting means...".

Support for the amendments to Claims 1 and 13 can be found throughout Applicant's specification, for example at FIGS. 4 and 5; and page 12, lines 11 – 22. Therefore, the present amendments do not introduce new subject matter into the disclosure.

### **I. Rejection of Claims 4, 7, 10, 12 and 15 Under 35 U.S.C. § 112, First Paragraph**

Claims 4, 7, 10, 12 and 15 are rejected under 35 U.S.C. § 112, first paragraph as allegedly failing to comply with the enablement requirement. According to the Examiner, the claims recite subject matter that was not described in the specification in such a way as to enable one skilled in the art to make and/or use the invention.

Specifically, Claim 4 recites "an incision mode designating group" identified in Table 1 as being one of "urology", "mix 1", "mix 2" or "pure"; and "a clotting mode designating group" identified in Table 1 as being one of "soft" or "soft A". The Examiner contends that these are not conventional terms in the art and thus do not enable a skilled artisan to make or use the

invention. In addition, Claims 7 and 10 recite “a set fluid amount designating group”, however according to the Examiner, it is not clear to a skilled artisan what “fluid amount” is being modified.

In response, Applicant submits an operation manual for a commercially available control unit for endosurgery, titled: “Instructions Olympus Integrated Endosurgery System EndoALPHA Control Unit for Endosurgery UCES” (hereinafter, “EndoALPHA manual”); and an operator’s manual for ConMed System 5000 electrosurgical unit (hereinafter, “System 5000 manual”).

With respect to the incision mode designating group recited in Claim 4, EndoALPHA manual clearly discloses a cut mode selector switch, which allows the selection of a cut mode of “pure”, “blend 1” and “blend 2”. (See: page 87, item 10). In addition, the terms “pure”, “blend 1” and “blend 2” are disclosed as operational modes in System 5000 manual as well. (See: page 1-7, table 1.2.11).

One of ordinary skill in the art would recognize the cut mode selector switch as being an incision mode selector switch. Additionally, the terms “mix 1” and “mix 2” would also be recognized by one of ordinary skill in the art as referring to “blend 1” and “blend 2”.

Furthermore, those of ordinary skill in the art would understand the term “urology” in reference to an incision mode selector switch to refer to an incision mode optimized for use in a urology endosurgical procedure.

Referring now to “a clotting mode designating group” recited in Claim 4, and identified in Table 1 as comprising of “soft” or “soft A”. Applicant submits that both “soft” and “soft A” are well known coagulation mode terms as understood by those of ordinary skill in the art, as is evident from the disclosure of EndoALPHA manual. (See: page 85, item 7).

With respect to a set fluid amount designating group recited in Claims 7 and 10, one of ordinary skill in the art would recognize that the fluid is physiological brine, which is widely used in endosurgery.

Claims 12 and 15 recite “an instruction necessary for checking the setting”. The Examiner contends that it is not clear to a skilled artisan what device has a setting or what needs to be checked with respect to the setting. However, the rejection with respect to Claims 12 and 15 are rendered moot, as these claims have been canceled.

Therefore, Applicant respectfully avers that the incision mode designating group, the clotting mode designating group, and the set fluid amount designating group are fully enabled, as one of ordinary skill in the art would fully understand the meaning of these conventional terms, and thus would be able to implement Applicant’s invention without undue experimentation or development. Accordingly, Applicant respectfully requests withdrawal of the rejection with respect to Claims 4, 7 and 10 under 35 U.S.C. § 112, first paragraph.

## **II. Rejection of Claims 1 – 12 and 15 Under 35 U.S.C. § 112, Second Paragraph**

Claims 1 – 12 and 15 are rejected under 35 U.S.C. § 112, second paragraph as allegedly indefinite for failing to particularly point out and distinctly claim the subject matter that Applicant regards as the invention. The rejection with respect to Claims 12 and 15 are rendered moot, as these claims have been canceled.

Specifically, Claims 4, 7, 10 are rejected for the above-identified reasons; and Claim 1 is rejected for reciting: “a voice and character converting step” as this is a method step, no apparatus appears to be claimed.

However, the rejection with respect to Claims 4, 7, 10 is believed obviate for the same reasons as indicated above. In addition, amended Claim 1 recites: "...voice and character converting means..." which adequately overcomes the rejection with respect to Claim 1.

Further, Claims 2 – 11 are rejected because these claims incorporate the subject matter of Claim 1 from which they depend. However, the rejection with respect to Claims 2 – 11 is believed obviate for the same reasons as indicated above in reference to Claim 1.

Accordingly, Applicant respectfully requests withdrawal of the rejection with respect to Claims 1 – 11 under 35 U.S.C. § 112, second paragraph.

### **III. Rejection of Claims 1 – 3, 5, 6 and 8 – 16 Under 35 U.S.C. § 102(e)**

Claims 1 – 3, 5, 6 and 8 – 16 are rejected under 35 U.S.C. § 102(e) as allegedly anticipated by U.S. Patent No. 6,911,916 issued to Wang et al.

Wang et al. discloses a voice control system for controlling various surgical devices, including electro-cautery and insufflator devices. However, Wang et al. fails to teach issuing an audible verification request when an instruction is received that is predetermined to require verification prior to execution, as recited in Applicant's Claims 1 and 13.

Accordingly Applicant respectfully requests withdrawal of the rejection with respect to Claims 1 – 3, 5, 6 and 8 – 16 under 35 U.S.C. § 102(e) over Wang et al.

### **IV. Rejection of Claims 4, 7 and 10 Under 35 U.S.C. § 103(a)**

Claim 4 is rejected under 35 U.S.C. § 103(a) as allegedly obvious over Wang et al. in view of U.S. Publication No. 2003/0139789 issued to Tvinnereim et al.; and Claims 7 and 10 are rejected under 35 U.S.C. § 103(a) as allegedly obvious over Wang et al. in view of U.S. Patent No. 6,402,714 issued to Kraft-Kivikoski.

Neither Tvinnereim et al. nor Kraft-Kivikoski disclose a system or method of voice-controlling medical devices, but rather only disclose an insufflator device (See: Kraft-Kivikoski) and an electro-cautery device (See: Tvinnereim et al.). Consequently, neither Tvinnereim et al. nor Kraft-Kivikoski, taken alone or in any proper combination with Wang et al., disclose or suggest a verification requesting means for issuing an audible verification request when the instruction is predetermined to require verification prior to execution, as recited in Applicant's Claim 1.

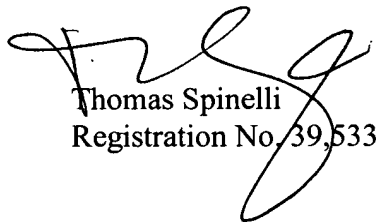
Therefore, Claims 4, 7 and 10 are believed to be allowable over the cited prior art references for at least the reasons provided above with regards to Claim 1 from which Claims 4, 7 and 10 depend. Accordingly Applicant respectfully requests withdrawal of the rejections with respect to Claim 4 under 35 U.S.C. § 103(a) over Wang et al. in view of Tvinnereim et al.; and Claims 7 and 10 under 35 U.S.C. § 103(a) over Wang et al. in view of Kraft-Kivikoski.

### **CONCLUSIONS**

In view of the foregoing amendments and remarks, it is respectfully submitted that all claims presently pending in the application, namely, Claims 1 – 11, 13, 14 and 16 are believed to be in condition for allowance and patentably distinguishable over the art of record.

If the Examiner should have any questions concerning this communication or feels that an interview would be helpful, the Examiner is requested to call Applicant's undersigned attorney at the number indicated below.

Respectfully submitted,



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